REMARKS

A final Office Action was mailed on October 22, 2003. Applicant's timely mailed a Response to Office Action on April 22, 2204, together with a Petition for a three-month extension and Notice of Appeal. An Advisory Action was mailed on May 14, 2004, indicating that the Response of April 22 would not be entered. The present Preliminary Amendment is being timely mailed together with a Request for Continued Examination.

Claims 1 – 6, 8 – 14 and 16 – 56 are pending in the present application. Applicants cancel claims 1 – 6, 8 – 14 and 29 – 43 without prejudice or disclaimer, amend claims 16, 22, and 50, and add new claims 57 and 58. No new matter is added. Support for the amendments may be found, for example, in Applicants specification at page 28, line 21 – page 29, line 21, page 66, line 10 – page 68, line 10 and page 71, line 23 – page 72, line 3.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1 – 6, 8 – 14 and 16 - 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,764,736 to Shachar et al. in view of U.S. Patent No. 5,919,247 to Van Hoff et al. and U.S. Patent No. 4,995,074 to Goldman et al. Claims 29 – 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shachar in view of

Goldman. Applicants cancel claims 1 – 6, 8 – 14 and 29 – 43 without prejudice or disclaimer, amend claim 16 to correct a minor typographical error, amend independent claims 22 and 50 to clarify the nature of their invention, add new claims 56 and 57, and respectfully traverse these rejections.

In an Amendment of August 11, 2003, Applicants made the following arguments to distinguish the claimed invention over the cited references:

> Applicants disclose a communication system permitting data and voice communications between a server and a terminal over a single communications line, such that a voice call can be made between the terminal and a third party after initiating a data communications session and without terminating the data communications session. This ability to maintain the data communications session during the voice call is facilitated by temporary line disconnection units present in each of the server and the terminal, which mediate the disconnection and reassignment of the communication line to the voice call without issuing any disconnection notifications to upper layer applications each of the server and terminal. As a result, the upper layer applications in each of the server and the terminal remain in while waiting for data communications to resume.
>
> In particular, for example, by Applicants' independent claims 1, 9, 16 and 22, the communication system and associated method provide for automatically fetching and storing in the terminal data associated with a data application in the server, so the upper layer application in the terminal may continue to operate during disconnection of data communications and the automatically-fetched data may continue to be displayed by the terminal during voice communications, so that "virtual" data communications may proceed during voice communications.
>
> Shachar discloses a method for manipulating voice and data connections between a data communication session and voice communication. In the event that a voice communication is requested during a data communication session, the method provides a means for storing information about the data communication session. Van Hoff discloses a system for distributing application code and data from a server to a client. A "tuner" application is used by the client to automatically request code and data updates to be delivered by a "transmitter" in the server. As acknowledged by the Examiner, neither Shachar nor Van Hoff teach or suggest Applicants' claimed temporary line disconnection unit provided in each of the terminal and server for disconnecting a data communications line without issuing disconnection notifications to upper

layer applications of the terminal and server. The Examiner suggests that this limitation however is taught by Goldman.

> Goldman discloses a switched line modem interface system that comprises a user terminal interface 28 and a host interface 34 that support suspension of a data communication session when the user proceeds to make a voice call. The interfaces 28, 34 support suspension of the data communication session by causing modem carrier signals to be maintained, by providing a "host not ready" signal to a user terminal 14 and by dropping a "terminal ready" signal to host 16. Thus, in sharp contrast to Applicants' claimed system, Goldman does not enable resumption of data communications by simply disconnecting the line used for data communication without providing disconnection notification to upper-level applications, but rather actively and continuously provides disconnection notice to the terminal in the form of a "host not ready" signal to the host by dropping the "terminal ready" signal.

The Examiner finds this argument unpersuasive, suggesting that the suspension of data communications taught by Goldman is equivalent to the disconnection of the data communication line taught by Applicants. Applicants respectfully submit that Applicants' claimed temporary line disconnection means and method can be further distinguished from Goldman as including means for "monitoring a content of received data from the server and from the terminal, and when specified data is received, disconnecting [the] line".

This monitoring means, for example, enables each of the terminal and server in Applicants' claimed invention to directly initiate and/or perform a temporary line disconnection. Thus, unlike Goldman, Applicants' claimed invention need not wait for a call waiting signal provided by a third party caller in order to perform a temporary line disconnection (see, e.g., column 4, lines 31 to 41 of Goldman), but rather may proceed in response to its own request or a request initiated by the server. In addition, by monitoring received data from the terminal or server for a line disconnection request, Applicants' claimed invention avoids the need for supporting the additional specialized signaling

interfaces required by Goldman (for example, off-hook detector 29) to signal a line disconnection request.

In the Advisory Action of May 14, the Examiner suggests that the carrier signals in effect provide Applicants' claimed "specified data". However, in sharp contrast to Applicants' claimed invention, the carrier signals of Goldman are not signals "received from the server".

With respect to amended claims 22 and 50, Applicants submit that these claims may be further distinguished from the cited references by the current amendments requiring that the claimed terminal include:

> means for fetching, from the server, data which is not being accessed by the upper layer application, and for storing the obtained data during the data communications with the server, and
>
> means for passing the stored data to the upper layer application during the voice communications with the third party
>
> (Emphasis added)

Applicants respectfully submit that none of the cited references, either alone or in combination, teach or suggest these amended features of Applicants' claimed invention.

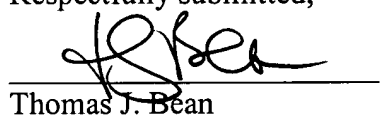
In light of the arguments presented above, Applicants' respectfully submit that their invention as claimed in independent claims 16, 22, 44 and 50 is not made obvious by any combination of Shachar, van Hoff and Goldman, and therefore stands in condition for allowance. As claims 17 –21, 23 – 28, and 45 – 49 and 51 – 56 each depend from one of allowable claims 16, 22, 44 and 50, Applicants respectfully submit that claims 17 –21, 23 – 28, and 45 – 49 and 51 – 56 are allowable for at least this reason.

CONCLUSION

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1 – 16 – 28 and 44 - 58, consisting of independent claims 16, 22, 44, 50, 56 and 57, and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, he is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

We respectfully request that all fees relating to this application be charged to Deposit Acct. No. 50-1290.

Respectfully submitted,



Thomas J. Bean
Reg. No. 44,528

CUSTOMER NUMBER 026304

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NEW YORK 10022-2585
PHONE: (212) 940-8800/FAX: (212) 940-8776
DOCKET No.: FUJO 14.691 (100794-10585)